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Paper No. 26
BAC

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JUNE 3, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Maktab Tarighe Oveyssi Shah Maghsoudi

v.

International Association of Sufism

Cancellation No. 23,044

Joseph D. Lewis of Cleary, Komen & Lewis, LLP for Maktab
Tarighe Oveyssi Shah Maghsoudi.

Michael B. Newman of Buchman & O'Brien for International
Association of Sufism.

Before Cissel, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Maktab Tarighe Oveyssi Shah Maghsoudi, a non-profit
corporation of California (hereinafter petitioner), has
filed a petition to cancel a registration issued to
International Association of Sufism (hereinafter respondent)
for the mark shown below

for a "magazine."¹

Petitioner asserts as grounds for cancellation that since long prior to respondent's adoption of the term "SUFISM" for magazines, petitioner has continuously published and distributed in interstate commerce various printed publications in the field of Sufism; that petitioner has an equal or greater right to use the term "SUFISM" in connection with publications, including magazines; that respondent has never used the mark in the form it appears in the registration; that respondent has abandoned the stylized form of the mark as it appears in the registration; that the registration is void ab initio because respondent was not and is not an unincorporated association as asserted in the application; and that respondent's mark is merely descriptive or generic when used in connection with magazines.²

In its answer respondent has denied the salient

¹ Registration No. 1,682,885, issued April 14, 1992, Section 8 affidavit accepted. The claimed date of first use and first use in commerce is March 25, 1988. The registration issued under Section 2(f) of the Trademark Act.

² Regarding the grounds that respondent did not use the mark as shown in the registration, that respondent abandoned the stylized registered form of the mark, and that the registration is void because respondent was not an unincorporated association as stated in the application, petitioner did not offer any evidence during trial or any argument in its brief on these issues. Accordingly, we will not address them.

allegations of the petition to cancel, and raised the affirmative defense that "Registrant's mark has become distinctive through acquired secondary meaning and serves as an indication of the source or origin of Registrant's goods."

The record consists of the pleadings; the file of respondent's registration; the testimony, with exhibits, of Karin Heissler, petitioner's program assistant; the testimony, with exhibits, of Sulayman S. Nyang, professor of African studies in the Department of African Studies at Howard University;³ petitioner's notice of reliance on a photocopy of the file of application Serial No. 74/368,720; petitioner's notice of reliance on (i) certain of respondent's answers to petitioner's first set of interrogatories, and (ii) a photocopy of a printed publication entitled Sufism; and respondent's notice of reliance on (i) certain of respondent's answers to petitioner's first set of interrogatories, (ii) a photocopy of respondent's request to correct its certificate of registration⁴, (iii) photocopies of several issues of respondent's magazine, (iv) photocopies of several of respondent's advertisements, and (v) a photocopy of "the

³ Respondent did not attend the depositions of Karin Heissler or Professor Sulayman Nyang.

⁴ On June 24, 1997, the Patent and Trademark Office acted on respondent's correction paper, amending Reg. No. 1,682,885 to indicate that respondent is an incorporated association.

uncorrected proof of a future book entitled Essential Sufism. For rebuttal, petitioner submitted a notice of reliance on (i) certain of respondent's answers to petitioner's first set of interrogatories, (ii) photocopies of various publications relating to "Sufism," and (iii) photocopies of various encyclopedias. Late in the case (at the time of filing of petitioner's reply brief) the parties stipulated three documents into the record, specifically, (i) a photocopy of a registration (No. 1,655,795) owned by Nader Angha, dba **Maktab Tarighe Oveyssi ShahMaghsoudi**, (ii) **a photocopy of a petition to cancel filed by respondent against Nader Angha's Registration No. 1,652,335, and (iii) a photocopy of a May 29, 1997 letter from respondent's attorney to petitioner's attorney.**

Both parties filed briefs on the case and were represented by counsel at an oral hearing held before the Board.

I. Preliminary Matters

At the outset, we note that petitioner did not specifically plead that respondent's mark had not acquired distinctiveness, but it is clear that the issue was tried by the implicit consent of the parties and argued in the briefs. See Fed. R. Civ. P. 15(b); and TBMP §§322 and

507.03(b). Accordingly, we deem petitioner's pleading to be amended to conform to the evidence.⁵

Next, we determine petitioner's objections to two items offered into evidence by respondent through a notice of reliance. Specifically, petitioner objects to (i) respondent's answers to petitioner's interrogatory Nos. 9, 15, and 21-25, and (ii) the title page, the publication page, and the back cover page of an uncorrected proof of a future book, titled Essential Sufism.

First, regarding respondent's responses to petitioner's interrogatories, Trademark Rule 2.120(j)(5) requires that if an inquiring party offers into evidence fewer than all of the responding party's answers to interrogatories, the responding party may introduce by notice of reliance other answers which should in fairness be considered. The rule requires that the responding party support in writing why it needs to rely on the additional discovery responses. In this case respondent included no reason relating to fairness in its notice of reliance. Later, in response to petitioner's objection, respondent merely commented that petitioner offered fewer than all of respondent's answers to

⁵ For the sake of clarity, we note that petitioner contends the Board may order cancellation of the registration of the mark SUFISM on any of four bases, namely, (i) that the term is generic for the involved class of publications, (ii) that the term is a generic religious term, (iii) that the term is merely descriptive and lacked secondary meaning at the time of registration, and (iv) that the term is merely descriptive and presently lacks secondary meaning.

petitioner's interrogatories and "Respondent is introducing into evidence the answers not offered by Petitioner, which if absent would make Petitioner's evidence incomplete and misleading." (Respondent's brief, p. 2). Respondent restated the rule but did not indicate with any specificity why these particular answers should in fairness be considered in this case. See *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, footnote 5 (TTAB 1988); and TBMP §710. Petitioner's objection is well taken, and we have therefore not considered this evidence.

Second, we consider respondent's offer of an uncorrected proof of a future book. Trademark Rule 2.122(e) provides, in relevant part, for introduction by way of notice of reliance on printed publications available to the general public in libraries or of general circulation among members of the public or a relevant segment of the public. Respondent contends that it is not relying on the pages offered for proof of the truth of the content, but for the fact that there is a specific reference on the back cover to respondent. However, respondent offered no authority for such reliance. It is obvious that an uncorrected proof of a future book is not a printed publication within the meaning

of Trademark Rule 2.122(e). Petitioner's objection is well taken, and we have not considered this evidence.⁶

In summary, the Board has not considered respondent's answers to petitioner's interrogatory Nos. 9, 15 and 21 - 25, or the uncorrected proof of the book Essential Sufism.

II. The Parties

Petitioner, whose name translates, in part, to "school of Sufism", is an international non-profit religious/educational corporation, headquartered in San Rafael, California. Petitioner teaches and practices Sufism (the mysticism of Islam), through operating centers for the study of Sufism throughout the United States and the world. Petitioner is an Iranian Sufi order headed by Nadar Angha, its 42nd holy teacher, and petitioner traces its lineage to the advent of Islam in the seventh century A.D. Petitioner publishes a variety of publications in the field of Sufism, under titles such as *Sufism*, *Sufism and Wisdom*, *Sufism and Islam*, *Sufism and Peace*, and *Sufism and Knowledge*.

Petitioner also offers cassette tapes such as "The Reality of Religion-Sufism Inside Islam." In addition, petitioner offers programs in meditation, and it conducts community welfare activities.

⁶ The Board notes that in petitioner's rebuttal notice of reliance, it offered into evidence the title page, the

Respondent, established in 1983, is an international non-profit association of various Sufi groups. Also located in San Rafael, California, respondent is dedicated to the promotion and advancement of Sufism, the "inner path" or mystical branch of the Islam religion. Respondent publishes a variety of books, newsletters and a quarterly journal⁷; organizes an annual symposium on Sufism; and conducts various educational classes, seminars, and courses.

III. The Record

Petitioner submitted several dictionary definitions of the term "Sufism" including the following as examples:

(1) Term generally applied to mystical currents in Islam. The word is derived from *suf* (Arab., 'wool'), pointing to the woolen frocks of Middle Eastern ascetics; an etymologically incorrect derivation is from either *safa* ('purity') or from the Greek *sophos* ('wise'). The Harper Collins Dictionary of Religion (1995);

(2) The mystical heart of **Islam**, Sufism insists on total submission to Allah as the road to ultimate truth. The word *sufi* denotes a wearer of wool and indicates belief in simplicity and poverty. The aim of the Sufi is to be 'in the world but not of it.' There have been many different schools of Sufism which have been attacked by Islamic purists. Sufism has inspired poetry, music and dance." (Emphasis in original.) Body

publication page, and the table of contents of the published version of the "uncorrected proof" book.

⁷ The quarterly journal is the magazine which is sold under the title "SUFISM," and is the subject of the registration which is involved in this cancellation proceeding.

Mind & Spirit A Dictionary of New Age Ideas, People, Places, and Terms (1994);

(3) The doctrine of the Sufis⁸, which has inspired a mass of symbolical religious poetry. Funk & Wagnalls Standard Dictionary of the English Language (1974);

(4) Sufi n. Muslim mystic--Su'fic adj.; Su'fism n. The Oxford Desk Dictionary (1995);

(5) A sect of Islamic mysticism, dating from the eighth century A.D. and developed chiefly in Persia. The American Heritage Dictionary of the English Language (1976); and

(6) Ascetic Islamic mysticism originating in the 8th century and developing esp. in Persia into a system of elaborate symbolism of which the goal is communion with the deity through contemplation and ecstasy. Webster's Third New International Dictionary (1986).

In addition, the record includes several encyclopedias and other reference works relating to "Sufism." The following are representative samples:

(1) *Islam In North America: A Sourcebook* (1992) with a section titled "Sufism in North America: A Bibliography" and with an introductory paragraph stating "Of the numerous books written on Sufism, these introductory and survey texts were selected because of their coverage of a variety of different Sufi groups. There are literally hundreds of Sufi orders which have been formed across the Islamic world and as yet no international guide to them has appeared, though some excellent work has

⁸ The term "Sufi" is defined in this Funk & Wagnalls Standard Dictionary as "A follower of a system of Moslem philosophical and devotional mysticism, especially in Persia."

been done on the major Persian and Indian orders.";

(2) *Eastern Definitions - A Short Encyclopedia of Religions of the Orient* (1978) with a section on "Sufi, Sufism";

(3) *Encyclopedia of Mysticism and Mystery Religions* (1982) with a section on "Sufism";

(4) *1994 Resource Directory of Islam in America* with a section titled "Sufism-Spirituality";

(5) *Encyclopedia of American Religions* (1996 fifth edition) listing a chapter "Middle Eastern Family, Part II: Islam, Zoroastrianism, and Baha'i--Includes Islam, Sufism, Black Islam, Zoroastrianism, Baha'i, The Druze; and

(6) *The Concise Encyclopedia of Islam* (1989) with a listing for "Sufism."

Through the testimony of Karin Heissler, petitioner's program assistant, petitioner put into the record copies of some of its own publications, namely, *Sufism, Sufism and Wisdom, Sufism and Islam, Sufism and Peace, and Sufism and Knowledge*. These publications comprise a four-part lecture series on Sufism. Petitioner's brochure about its organization is titled "Sufism The Way to Oneness."

Karin Heissler also testified that she conducted a search of the word "Sufism" at the Library of Congress and she photocopied the cover, the title page and the Library of Congress page of publications which included "Sufism" in the title. Examples of these are Sufism An Account of the

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Mystics of Islam (1950) by A. J. Arberry; Sufism Its Saints and Shrines (1970) by John A. Subhan; What is Sufism? (1977) by Martin Lings; Sufism The Mystical Doctrines and Methods of Islam (1976) by William Stoddart; Jalaluddin Rumi: Songbird of Sufism (1980) by Roy c. DeLamotte; Sufism Meaning, Knowledge, and Unity (1981) by Dr. Javad Nurbakhsh; Talks on Sufism When You Hear Hoofbeats Think of a Zebra (1987) by Shems Friedlander; Mystical Islam An Introduction to Sufism (1989) by Julian Baldick; Contemporary Relevance of Sufism (1993) by Syeda Saiyidain Hameed; Sufism The Alchemy of the Heart (1993) by Dr. M. I. Waley; Sufism, Mystics, and Saints in Modern Egypt (1995) by Valerie J. Hoffman; and Sufism and Islamic Reform in Egypt (1996) by Julian Johansen.

Ms. Heissler also testified that the Library of Congress' publication titled "Subject Headings" lists "Sufism" as a main heading in the catalog system; and that the "Subject Guide to Books in Print 1996 - 1997" lists "Sufism" as a subject heading. Finally, she testified that she searched the Internet under the word "Sufism" and retrieved several references, including the following: "Nimatullahi Sufi Order-principles and practices of the Nimatullahi Sufi Order. Includes books on Sufism, the Sufi magazine, poetry and music."

Petitioner also took the testimony of Sulayman S. Nyang, professor of African studies in the Department of African Studies at Howard University, as an expert on the Islamic religion. He testified that "Sufism" and "Sufi" are two forms of the same word in that one is a body of beliefs, values and methods usually identified with Islam, while the other is a person who practices the particular religion; that the term "Sufism" does not describe any one particular group or organization, but rather is a universal term and there are "hundreds of different groups around the world who will claim to be part of the intellectual, more or less, morality and spiritual movement called 'Sufism'" (dep. p. 13); and that usually each different Sufi order is named after the founder of that particular order.

Further, he searched his personal library of over 5,000 books, locating numerous books and publications with the word "Sufi" or "Sufism" in the title and/or the table of contents, such as Sufi Thought and Action (1990) assembled by Idries Shah, Tales from the Land of the Sufis (1994) by Mojdeh Bayat and Mohammad Ali Jamnia (with chapters titled "A Brief Look at the History of Sufism" and "Hallaj: The First Martyr of Sufism"), A Sufi Saint of the Twentieth Century (1961) by Martin Lings, Sufi Essays (1977) by Shyyed Hossein Nasr (with chapters titled "Sufism and the Integration of Man" and "The Spiritual States of Sufism"),

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What is Sufism? (1977) by Martin Lings (with chapters titled "The Originality of Sufism," "The Universality of Sufism" and "Sufism throughout the Centuries"; Scholars, Saints, and Sufis - Muslim Religious Institutions Since 1500 (1972) edited by Nikki R. Keddie; and Sufi Mystics of the Niger Desert (1990) by H. T. Norris.

Petitioner submitted evidence of numerous third-party uses of the term through a notice of reliance on publications such as, Sufism I (1981), Sufism II (1982), Sufism III (1985), and The Psychology of Sufism (1992), all by Dr. Javad Nurbakhsh; "Threshold - A Journal of Sufism" published by the Threshold Society in Brattleboro, Vermont; An Introduction to Sufism (1990) by Titus Burckhardt; Sufism (1983) by Dr. Ronald Grisell (with the two major portions of the book, as shown by the table of contents, titled "The Theory, Practices and Origins of Sufism" and "The Centers of Sufism: Past and Present"); and Essential Sufism (1997) edited by James Fadiman and Robert Frager.

Respondent put into evidence (by means of a notice of reliance) copies of its own publication and advertisements of its magazine, including respondent's catalog, respondent's web site, and programs from respondent's annual "Sufism Symposium."

IV. Genericness

Section 14(3) of the Trademark Act, 15 USC §1064(3), permits cancellation if the "registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered... A registered mark shall not be deemed to be the generic name of the goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used."

The test for determining whether a designation is generic, as applied to the goods in the registration, turns upon how the term is perceived by the relevant public. See *Loglan Institute Inc. v. Logical language Group, Inc.*, 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992). Determining whether an alleged mark is generic involves a two step analysis: (1) What is the genus of the goods or services in question? and (2) Is the term sought to be registered understood by the relevant public primarily to refer to that genus of goods or services? See *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986); and *In re Web*

Communications, 49 USPQ2d 1478 (TTAB 1998). In fact, in the H. Marvin Ginn case, supra at 531-532, the Court refined the above-stated test for determining the genericness of a magazine title to be "First, what is the class of publications or magazines at issue? Second, is the title understood by the relevant public to refer primarily to that class of magazines?"

Evidence of the public's understanding of a particular term may be obtained from any competent source, including direct testimony of consumers, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications. See Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); In re Merrill, Lynch, Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); and In re Northland Aluminum Products, Inc., 777 F.2d 1566, 227 USPQ 961 (Fed. Cir. 1985). The party asserting genericness must prove its claim by a preponderance of the evidence. See Magic Wand Inc., supra, at 1554.

The key consideration in determining genericness is the relevant public's understanding of the term. That is, do the members of the relevant public understand or use the term to sought to be protected to refer to the genus of goods or services in question. In this case, the majority of persons coming into contact with respondent's publication

will be adherents of Sufism. Thus, the relevant public here consists of adherents of Sufism. See *Stocker v. General Conference Corp. of Seventh-day Adventists*, 39 USPQ2d 1385, at 1394 (TTAB 1996).⁹

Petitioner's evidence of dictionary definitions, encyclopedic excerpts, third-party publication titles (many including chapters or sub headings with the term "Sufism"), book catalog headings, and petitioner's own use of the term "Sufism" on its publications demonstrates that the term is a reference to a particular class of publications. We note also the testimony of petitioner's expert witness, but we acknowledge that the test is not the understanding of an expert, but rather that of the relevant public.

In addition, in answering an interrogatory about the subject matter of its magazine published under the mark SUFISM, respondent answered as follows: "The subject matter of the magazines sold by Respondent under Respondent's mark is Sufism, Islam, and various other subjects of spiritual, religious and metaphysical significance." (Respondent's answer to petitioner's interrogatory No. 8). Respondent

⁹ We note that petitioner stated at page 9 of its brief that "The relevant public in this case comprises adherents of Sufism." Respondent did not contest this statement, and appears to agree because respondent made the following statements in its brief: "The relevant public, the magazine's readers, purchasers and subscribers..." (page 6), "...Respondent's quarterly journal or magazine it publishes for its members, readers, purchasers and subscribers..." (page 7), and "...Respondent's publication is directed to a relatively small and informed group of persons interested in Sufism and related subjects..." (page 9).

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sponsors a Sufism symposium each year, and submitted the programs from three such symposiums, which are titled as follows: (i) "1995 Annual Sufism Symposium A Weekend of Unity & Self Discovery," (ii) "Third Annual Sufism Symposium 1996 Expressions of Beauty and Sufism," and (iii) "Sufism Symposium '97 Sufism: An Old Tradition for A New World." Respondent's web site includes click-on topic buttons including "About Sufism" and "Annual Symposium."

There is clear evidence showing the term "Sufism" used as all or part of the names of other journal publications, including "Threshold - A Journal of Sufism" from the Threshold Society, and petitioner's own works titled "Sufism", "Sufism and Knowledge", "Sufism and Wisdom" and "Sufism and Islam." In addition, there is ample evidence of many published works by third parties in which the title consists in whole or in principal part of the term "Sufism." Moreover, the evidence establishes use of the term "Sufism" on publications from the 1940s to the present day.

Based on this evidence, we find that the term "Sufism" names a class of publications on "Sufism." We also find that the relevant public --the adherents of Sufism-- understands the term to refer to the publications. That is, the primary significance to the relevant public of the term "Sufism," used in connection with publications, is that it is a class of publications on the topic of Sufism. The

members of the relevant public, i.e., the adherents of Sufism, who would be interested in a magazine about "Sufism" would understand the term to refer to the type of magazine, and not to the source of the magazine. "Sufism" names a class of publications devoted to the history, writings, teachings, poetry, and other matters related to "Sufism." See Reese Publishing Company, Inc. v. Hampton International Communications Inc. et al., 620 F.2d 7, 205 USPQ 585 (2nd Cir. 1980)(holding VIDEO BUYER'S GUIDE to be generic for a magazine).

Respondent's reliance on the case of In re Waverly Inc., 27 USPQ2d 1620 (TTAB 1993), does not persuade us that we must reach a different result herein. The Waverly case was an ex parte appeal of a refusal to register, and was thus based on an ex parte record, where doubt on the issue of genericness is resolved in favor of the applicant. Further, in that case, the applicant had established 70 years of substantially exclusive and continuous use of the term "MEDICINE" on a journal published periodically.

That situation is easily distinguished from the one established by this inter partes record, where plaintiff's burden of proof is the preponderance of the evidence and there is no resolution of doubt in respondent's favor. Also, here petitioner submitted ample evidence of the meaning of the term "Sufism," as well as evidence of

petitioner's own and numerous third-party uses of the term "Sufism" on publications. Respondent has used the term only a few years, and has submitted no evidence of consumer recognition of the involved term as a trademark.

Based on the record before us, we hold the term "Sufism" is generic for a class of publications.

Further, this record clearly establishes that the term "Sufism" is a generic term for a set of beliefs and that it should be available for use by all Sufi groups or orders. However, we disagree with petitioner's assertion that pursuant to the Stocker case, supra, a separate, independent ground for cancellation results when a term is the generic name for a set of religious beliefs. The Stocker case involved a petition to cancel registrations for, inter alia, "religious books, magazines, pamphlets, newsletters, brochures, encyclopedias, dictionaries, commentaries, fliers, bulletins, yearbooks, booklets and bibles"; "educational instruction services in academics at grade school, high school and college level"; and "conducting religious observances and missionary services." Thus, in that case, the question of the genericness of the term SEVENTH-DAY ADVENTIST as the name of a set of religious beliefs was determined, not in the abstract, but in connection with the involved goods and services (and of course, on the basis of the record presented by the

parties). Conversely, in the case now before the Board, respondent's only involved goods are magazines. There is no registration of the term "Sufism" for educational, religious or missionary services before us.¹⁰

Petitioner's interpretation of the Stocker case goes well beyond the holding of that case. The Court of Appeals for the Federal Circuit has clearly instructed that the question of genericness is to be determined only in specific relation to the involved goods or services. See H. Marvin Ginn, supra. The grounds for cancellation are found in Section 14 of the Trademark Act. The Stocker case does not create an independent additional ground for cancellation outside of the Trademark Act whenever an involved term is a religious term, regardless of the nature of the involved goods or services.

V. Descriptiveness / Acquired Distinctiveness

Having determined that the term "Sufism" is generic, we necessarily find that the involved registration must be cancelled. However, in the event it should be determined on appeal that the term is not generic, and for completeness of the record, we now consider petitioner's second basis for

¹⁰ Respondent's assertion that the question of whether a term is generic must be evaluated in relation to the goods and/or services is well taken (Brief, page 11), but we note that respondent acknowledged the term "Sufism" "has some religious resonance." (Respondent's brief, p. 11).

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its petition to cancel, namely that the term "Sufism" is merely descriptive, and lacked acquired distinctiveness either at the time of registration (April 1992) and/or currently lacks acquired distinctiveness.

Section 2(e)(1) of the Trademark Act, 15 USC §1052(e)(1), precludes registration of a mark on the Principal Register if it merely descriptive of applicant's goods or services. In this case, respondent affirmatively and clearly amended its application to seek registration pursuant to a claim of acquired distinctiveness, and the resulting registration issued under Section 2(f) of the Trademark Act.¹¹ By its actions respondent conceded that its applied-for mark was merely descriptive. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988); and *Congloleum Corporation v. Armstrong Cork Company*, 218 USPQ2d 528, 535 (TTAB 1983).

Thus, the only remaining issue before us (assuming the term is not generic) is whether respondent's asserted mark had acquired secondary meaning at the time of registration or has done so by now. See *Neapco Inc. v. Dana Corp.*, 12 USPQ2d 1746 (TTAB 1989)(involving a petition to cancel a

¹¹ In response to the Examining Attorney's refusal to register on the ground of mere descriptiveness, respondent submitted a statement that "Applicant believes that the mark has become distinctive of the Applicant's goods in commerce and desires to

registration not yet five years old based on mere descriptiveness and lack of secondary meaning. In that case, the Board stated that even when the petition to cancel was being resolved, if the registered mark possessed secondary meaning, the petitioner would nonetheless prevail if it established that as of the time of registration the mark had been merely descriptive and had been devoid of secondary meaning.) See also, *Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ2d 1501 (TTAB 1993).

While petitioner bears the initial burden to establish prima facie that respondent did not satisfy the acquired distinctiveness requirement of Section 2(f), the ultimate burden of persuasion under Section 2(f) on the issue of acquired distinctiveness is on respondent. In the Yamaha case, at 1006, supra, the Court stated as follows:

Yamaha strenuously asserts in its brief on appeal that the ultimate burden of persuasion under Section 2(f) on the issue of acquired distinctiveness is on Hoshino as applicant. We completely agree. "The burden of proving secondary meaning is on the party asserting it, whether he is the plaintiff in an infringement action or the applicant for federal trademark registration." 1 Gilson, *Trademark Protection and Practice* §2.09, at 2-72 (1987). As one of our predecessor courts stated in *In re Hollywood Brands, Inc.*, 214 F.2d 139, 140, 102 USPQ 294, 295 (CCPA 1954), when reviewing the refusal of a registration sought under Section 2(f), "[t]here is no

amend its application under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f)."

doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant for registration."

The plaintiff must go forward with a prima facie case, but once the plaintiff has established its prima facie case, then the "final" burden, that of going forward with evidence to overcome the plaintiff's prima facie case and establish acquired distinctiveness by at least a preponderance of the evidence, is on the defendant. See the Yamaha case, at 1006-1007, supra. There is no specific rule as to the exact amount or type of evidence necessary at a minimum to prove acquired distinctiveness, but generally, the more descriptive the term, the greater the evidentiary burden to establish acquired distinctiveness. See In re Bongrain International (American) Corp., 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); and the Yamaha case, at 1008, supra. See also, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 15:28 (4th ed. 1999).

In order to acquire secondary meaning, the statutory language in Section 2(f) requires that the mark must have "become distinctive of the applicant's goods in commerce."

Respondent essentially contends as follows:

"Consequently, the sufficiency of Respondent's evidences should be evaluated, not as Petitioner suggests in its brief based on the individual quantities of sales or promotional expenditures (Pet. Brief at 15), but on the *effectiveness* of the evidence presented, taken as a whole. In

other words, the whole being greater than the sum of its parts should be considered, especially in light of the overall effect. As discussed above, respondent is able to overcome any claim of genericness because of the truly limited category of goods Respondent has applied the mark to, namely, magazines (as opposed to the far broader category of religion or beliefs or philosophy). For this very same reason, and in view of the very small potential audience for the magazines, the relatively low levels of circulation, sales, and advertising and promotional expenditures have been sufficient, *in this case*, to establish secondary meaning and distinctiveness of the mark. In addition, the absence, as mentioned above, of any real competition in the field of magazine publications primarily dedicated to the subject matter of Sufism also tends to lower the threshold for establishing distinctiveness. In an uncrowded field with a limited esoteric and interested potential audience, far less advertising and promotion is required than in a highly competitive mainstream industry to the (sic) to make a magazine title distinctive. (Respondent's brief, p. 16-17---Emphasis in original).

Respondent's argument about the whole being greater than the sum of the parts is a bit metaphysical or abstract. We must concern ourselves with a practical application of trademark law relating to acquired distinctiveness of the term. We agree that the issue is the achievement of acquired distinctiveness, not the effort expended to do so. But even if we accept respondent's argument that its sales and advertising numbers need not be large because it has a very limited audience for its magazine, nonetheless

respondent has not shown that even its small audience of consumers perceives the term "Sufism" as respondent's trademark.

We consider first the question of the sufficiency of respondent's evidence supporting its claim of distinctiveness as of the time of registration. The only evidence in the record at the time of registration was that filed by the then applicant in response to the Examining Attorney's refusal to register the mark. In a response filed June 24, 1991, respondent's attorney offered, in toto, the following statement and evidence:

In support of Applicant's amendment [under Section 2(f)], Applicant would like the Patent and Trademark Office to consider the following:

a. Applicant has used the mark since March 25, 1988 when the first issue of *Sufism* was published and shipped in interstate commerce.

b. Applicant has expended approximately \$5000 on advertising, promotion, marketing, and distribution of *Sufism*.

c. *Sufism* is distributed in virtually every state of the United States and throughout the world by subscription and at bookstores and newsstands. *Sufism* has eight distributors in the United States.

d. *Sufism's* current circulation is approximately 5000 copies (including average subscriptions of approximately 500 per issue).

e. The total dollar sales volume has averaged approximately \$9000 per issue.

f. *Sufism* is promoted widely by (i) advertisements in other publications in the metaphysical field such as *Book People, Quest, Shaman's Drum, Meditation, Creation, Critique, and Common Ground* and (ii) distribution of brochures or flyers at shows, fairs, expositions, or other similar events. Samples of these advertisements and flyers are enclosed.

Nine samples of advertisements and flyers were submitted by respondent. The Examining Attorney accepted this showing and approved the application for publication under Section 2(f).

Respondent (as applicant) had submitted no affidavits from officers or knowledgeable employees of respondent association regarding its use of the term and the nature and extent of such use. Respondent also had submitted no affidavits from members of the purchasing public regarding consumer perception of the term. Rather, respondent made of record only the statement of respondent's attorney that the mark had been in use for three years, with \$5000 spent on "advertising, promotion, marketing and distribution"¹²; that the magazine was sold worldwide with approximately \$9000 in sales per issue; and that the circulation of the magazine was approximately 5000 copies per issue. None of the

¹² Based on respondent's attorney's wording in his statement, we must assume that the \$5000 figure is the total for all three years for all of the named functions.

figures (sales, advertising and distribution costs, or circulation) were specified to relate to the United States. We find that this evidence is insufficient to establish that the term "Sufism" had acquired distinctiveness under Section 2(f) of the Trademark Act at the time of registration in April 1992.

We turn now to the question of respondent's attempt to show that the term has by now acquired distinctiveness. Respondent's submission during prosecution of the application, plus respondent's submission during trial of copies of the front cover of several issues of its quarterly magazine, as well as several advertisements of its magazine dating from September 1988 through spring 1997, are simply not sufficient. At trial, respondent submitted no evidence of consumer recognition of the term "Sufism" as respondent's trademark for its magazine. Likewise, there is no testimony from officers or other knowledgeable employees of respondent regarding circulation or sales. The figures respondent made of record during the ex parte prosecution of its then application were general in nature and some were not even specific to use of the involved term in the United States. During this inter partes proceeding, respondent, in answering petitioner's interrogatories, (and as made of record by petitioner), stated that it "does not have precise numbers available but it estimates that average annual sales

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in dollars of the magazine sold in the United States is \$5200" (Answer to interrogatory No. 11); that it "does not have precise numbers available but it estimates that average annual advertising expense in dollars for the magazines is \$1500" (Answer to interrogatory No. 12-Petitioner's interrogatory included the limiting terminology "in the United States"); that it "does not have precise numbers available but it estimates that average circulation per issue of the magazine is 625 copies" (Answer to interrogatory No. 13--there was no limitation to the United States in either the question or the answer, but we will assume this number refers to the United States); and that it "does not have precise numbers available, but it estimates that average number of copies of magazines sold under Respondent's mark were distributed as follows: (a) by paid subscription: 345, (b) other sales of copies: 185, and (c) copies that were given away: 95" (Answer to interrogatory No. 14--again there was no limitation to the United States in either the question or the answer, but we will assume these numbers refer to the United States).

Moreover, in this case, petitioner has submitted significant evidence that numerous third-party publications use the term "Sufism" as the title or part of the title thereof. Many of them are dated prior to respondent's

claimed dates of first use and continue through to the present.

Thus, on the record before us, it is clear that purchasers continue to be confronted with numerous independent third-party uses of the term "Sufism" as the title of or part of the title of various publications, with virtually no evidence that the public recognizes the term as respondent's trademark. Hence, respondent's claim of acquired distinctiveness cannot be successful because the distinctiveness on which purchasers rely is lacking. See *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939 (Fed. Cir. 1984).

Given the highly descriptive nature of "SUFISM" for a magazine about Sufism, we would need to see a great deal more evidence than respondent has submitted in this case in order to find that the term has become distinctive as the indicator of a single source for such a magazine. See *In re Recorded Books Inc.*, 42 USPQ2d 1275 (TTAB 1997); *In re Leatherman Tool Group Inc.*, 32 USPQ2d 1443 (TTAB 1994); *In re Medical Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992); and *Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580 (TTAB 1987).

In summary, we hold that the term "Sufism" is generic for magazines, but even if the term is ultimately found not generic, the term is merely descriptive with insufficient

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proof to establish acquired distinctiveness under Section 2(f).

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Decision: The petition to cancel is granted.

R. F. Cissel

P. T. Hairston

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial
and Appeal Board